

### **REMARKS/ARGUMENTS**

Applicant has reviewed and considered the Office Action mailed on May 16, 2005, and the references cited therewith.

Claims 1, 4, and 8 are amended, claims 9, 10, 13-19, 27, and 30-33 are withdrawn, and claims 3 and 34-41 are canceled. Claims 1, 2, 4-8, 11, 12, 20-26, 28, 29, and 42-49 are pending in this application.

Applicant respectfully reserves the right to prosecute the subject matter of claims 34-41 in one or more divisional applications.

Applicant respectfully submits that the amendments to claims 1, 4, and 8 do not introduce any new subject matter and are intended to cover additional claimable subject matter fully supported by the originally filed specification.

Applicant notes that pending claims 42-49 were not addressed in the present office action. Applicant filed claims 42-49 in their response dated 22 February, 2005. Applicant respectfully requests consideration and allowance of claims 42-49.

### **§102 Rejection of the Claims**

Claims 1-7 and 20-25 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,364,823 Garibaldi, et al. (Garibaldi). Applicant does not admit that Garibaldi is indeed prior art and reserves the right to swear behind the same at a later date.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. In addition, the disclosure must teach the identical invention in as complete detail as is contained the claim, and must teach each and every claim element arranged as in the claim.

#### **Claim 1**

Applicant respectfully submits that Garibaldi does not teach the identical invention in as complete detail as is contained in claim 1, as amended. In addition, Garibaldi does not teach each and every claim element arranged as in claim 1.

Applicant's independent claim 1, as amended, recites a "vascular treatment device" that includes "a stent formed with a magnetically susceptible material

having a magnetic susceptibility that decreases within a preselected temperature range." From review of Garibaldi, Applicant is unable to locate any description of a stent formed with a magnetically susceptible material having a magnetic susceptibility that decreases within a preselected temperature range, as recited in claim 1. In contrast, Garibaldi first provides a "magnetic patch 120" having a "hoop 122 [that] causes the patch 120 to open to its normal (preferably round) shape" and that "[t]he patch 120 includes magnetic material, for example particles of a magnetically responsive material . . . [that] may be a permeable magnetic material or it may be a permanent magnetic material" (col. 7, line 64 – col. 8, line 11). Garibaldi indicates that the "patch 120" could "collectively form a continuous interior wall reinforcement, like a stent" (col. 8, lines 58-59).

Garibaldi then provides "an embolic agent . . . [that] is a flowable magnetic material that can be delivered through a microcatheter, but which hardens to form a solid embolic" (col. 11, lines 19-21). Garibaldi indicates that the "magnetic material in the embolic [can have] . . . a sufficiently high Curie temperature, that the temperature of the patient can be reduced below the Curie temperature of the magnetic embolic material . . . [where] [m]agnetic material whose Curie temperature are below normal body temperature . . . can be used to make the embolic material magnetic" (col. 13, lines 12-22). "The surrounding tissue wold [sic] be sub-cooled to a temperature below this point . . . so that the material is highly susceptible to the magnetic field [then] . . . the body would be allowed to warm up to normal body temperature and the filled aneurysm would lose its ferromagnetic properties" (col. 13, lines 22-29).

As illustrated, Garibaldi first discusses an apparatus ("the patch"), then separately discusses a material ("the embolic material"). Garibaldi does not teach that the magnetic material with the sufficiently high Curie temperature used in "the embolic material" is or could be used with "the patch 120." As such, Garibaldi does not teach the elements as arranged in claim 1, nor does Garibaldi shown an embodiment in as complete detail as is contained in the claim 1.

Applicant also respectfully submits that one skilled in the art would not be motivated to combine the magnetic material with the sufficiently high Curie

temperature with the "the patch 120." As discussed above, "the patch 120" includes a "hoop 122 of nitinol 'memory' wire" where the "hoop 122 causes the patch 120 to open" (col. 8, lines 3-7). Garibaldi does indicate that "other structure or construction can be provided to cause the patch to assume its extended configuration," but fails to teach or suggest what these other structures or constructions could be.

Applicant respectfully submits, however, modifying the "patch 120" with "the hoop 122" of nitinol and the magnetic material having the sufficiently high Curie temperature would render Garibaldi unsatisfactory for its intended purpose. As one skilled in the art appreciates, nitinol is a metal that remembers its geometry. After it is deformed, it regains its original geometry by itself during heating or, at higher ambient temperatures, during unloading.

Garibaldi indicates that the tissue surrounding the magnetic material needs to be super-cooled so that the material can be highly susceptible to a magnetic field. However, super-cooling "the patch 120" would run counter to allowing the nitinol of "the hoop 122" to obtain its predetermined shape. For example, once the patch 120 having the magnetic material was moved under the influence of the magnetic field, the patch 120 would then be warmed to allow the nitinol "hoop 122" to expand to its preconfigured shape. Upon warming, however, the nitinol of "the hoop 122" could move the patch 120 in unpredictable ways relative its location within the body, negating any potential benefit of having used the magnetic material having the sufficiently high Curie temperature. As such, Garibaldi would be rendered unsatisfactory for its intended purpose.

Applicant respectfully requests reconsideration and withdrawal of the 102 rejection for independent claim 1, as well as the claims which depend therefrom.

#### Claim 20

Applicant respectfully traverses the rejection of claim 20, as Garibaldi does not teach the elements as arranged in claim 20, nor does Garibaldi show an embodiment in as complete detail as is contained in the claim 20.

Applicant's independent claim 20 recites a "vascular treatment system" that includes "a medical device . . . [that includes] a magnetically susceptible material . . . having a Curie temperature in a preselected temperature range, such that the implantable device heats to a temperature sufficient to treat the treatment site when the electromagnetic field is applied."

In contrast, Garibaldi provides "an embolic agent" having the "magnetic material" that is susceptible to a magnetic field when super-cooled to a temperature below the Curie temperature of the magnetic material. So, Garibaldi is cooling the magnetic material when the electromagnetic field is applied, not heating.

Applicant's claim 20 recite that the "implantable device heats to a temperature sufficient to treat the treatment site when the electromagnetic field is applied." As such, Garibaldi does not teach all the elements as arranged in nor does Garibaldi teach an embodiment in as complete detail as is contained in the claim 20.

Applicant respectfully requests reconsideration and withdrawal of the 102 rejection for independent claim 20, as well as the claims which depend therefrom.

§103 Rejection of the Claims

Claims 8, 11, 12, 26, 28, and 29 were rejected under 35 USC § 103(a) as being unpatentable over Garibaldi. Applicant respectfully traverses the rejection as follows.

As discussed above for the 102 rejections, Garibaldi does not teach the elements recited in independent claims 1 and 20. As claims 8, 11, and 12 are dependent claims of independent claim 1, and claims 26, 28, and 29 are dependent claims of independent claim 20, the 103 rejection of claims 8, 11, 12, 26, 28, and 29 should be withdrawn.

Reconsideration and withdrawal of the 103 rejection for claims 8, 11, 12, 26, 28, and 29 are respectfully requested.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 236-0122 to facilitate prosecution of this matter.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AMENDMENT Commissioner of Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 8th day of August, 2005.

Sarah L. Reinhard  
Name

Sarah L. Reinhard  
Signature

Respectfully Submitted,  
Jan Weber

By his Representatives,  
BROOKS & CAMERON, PLLC  
1221 Nicollet Avenue, Suite 500  
Minneapolis, MN 55403

By:

Joseph C. Huebsch  
Joseph C. Huebsch  
Reg. No. 42,673

Date: Aug. 8, 2005